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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,688	07/19/2005	Gerhard Reich	23333	1619
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EXAMINER				
RONESL VICKERY M				
ART UNIT		PAPER NUMBER		
1796				
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09/08/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/542,688

Applicant(s)

REICH, GERHARD

Examiner

VICKEY RONESI

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. All outstanding rejections are withdrawn in light of applicant's amendment filed on 6/4/2008.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 6/4/2008. In particular, claims 8-31 are new. Thus, the following action is properly made final.

Claim Objections

4. Claims 11 and 18 are objected to for the following informalities:

With respect to claim 11, "organoisilicon" is misspelled and should read as --organosilicon--.

With respect to claim 18, the chemical name "2,2-dimethylpropanediol-2,3" is miswritten and should read as --2,2-dimethylpropanediol-1,3-- as supported in the specification on page 8, line 21.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. Claims 9-14, 20-22, 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Gray (WO 81/01857) in view of the evidence given by Schapel et al (US 4,029,593).

Gray discloses a coating powder mixed with hydrophobic silica aerogel in amounts of 0.5 to 3 parts per hundred part resin (page 8, lines 1-11). A disclosed silica aerogel is Aerosil R 972 which is a material having a particle size of 5-50 nm and surfaces that have been made hydrophobic by reacting with an alkyl chlorosilane (page 2, lines 31-37). Note in example 1 the use of pigment and filler additives (page 3, lines 15-28).

Gray does not teach that Aerosil R 972 is pyrogenic silica or pyrogenic silicic acid.

Schapel teaches that Aerosil R 972 is a pyrogenic silicic acid (col. 6, lines 31-35).

In light of the disclosure of Gray and in view of the evidence given by Schapel regarding Aerosil R 972, it is clear that Gray anticipates the presently claimed invention.

Note that while it is recognized that the phrase “consisting essentially of” narrows the scope of the claims to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, “consisting essentially of” is construed as equivalent to “comprising”. Further, the burden is on the applicant to show that the additional ingredients in the prior art, i.e. hardener, flow additives, etc, would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant’s invention, See MPEP 2111.03. Case law holds that “[i]f an applicant contends that additional steps or material in the prior art are excluded by the recitation of ‘consisting essentially of,’ applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant’s invention.” *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 15-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray (WO 81/01857) in view of Schapel et al (US 4,029,593) and further in view of Durand (US 5,334,631).

The discussion with respect to Gray and Schapel et al in paragraph 5 above is incorporated here by reference.

While Gray teaches that its hydrophobic silica is useful in any dry, free-flowing powder adapted for application to substrates by fusion coating process (page 1, lines 8-9), it fails to teach polyester or poly(meth)acrylate resins.

Durand discloses a powder coating composition and teaches that well-known powder coating resins include polyester and polyacrylates (col. 1, lines 59-61).

Given that Gray is open to the use of any powder resins and further given that Durand teaches that common powder coating resins include polyester and poly(meth)acrylate resins, it would have been obvious to one of ordinary skill in the art to pick such a common and well-known powder coating resin as taught by Durand in the powder coating composition taught by Gray.

7. Claims 18, 23-25, and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray (WO 81/01857) in view of Schapel et al (US 4,029,593) and further in view of Durand (US 5,334,631) and Chasser et al (US 6,069,221).

The discussion with respect to Gray, Schapel et al, and Durand in paragraph 6 above is incorporated here by reference.

While Durand discloses polyester resins, it fails to disclose specific polyester resins prepared from 2,2-dimethylpropanediol-1,3, ethylene glycol, and terephthalic acid and hardened with β -hydroxyalkylamide.

Chasser et al discloses an improved powder coating composition that exhibits improved adhesion to metal and corrosion resistance comprising polyester cured with β -hydroxyalkylamide (col. 15, lines 31-32), wherein the polyester is prepared from neopentyl glycol (2,2-dimethylpropanediol-1,3) (col. 4, line 34), ethylene glycol (col. 4, line 32), and terephthalic acid (col. 4, line 42).

Given that an improved powder coating composition is obtained by using a polyester and hardener like presently claimed as taught by Chasser et al, it would have been obvious to one of ordinary skill in the art to utilize the polyester powder coating resin in the powder coating composition taught by Gray, Schapel et al, and Durand.

Response to Arguments

8. Applicant's arguments filed 6/4/2008 have been fully considered but they are not persuasive. Specifically, applicant argues that Gray does not disclose a premix.

In response, first, case law holds that evidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 USC 102 rejections and therefore cannot overcome a rejection so based. *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973). Second, the presently claimed premix does not exclude other ingredients such as hardener and pigment because open semi-open claim language “consisting essentially of,” absent a clear indication of what the basic and novel characteristics are, “consisting essentially of” is construed as equivalent to “comprising”. Applicant has cited the examples of the specification as originally filed to support a criticality for using a premix in preparing powder coating compositions; however, this data is insufficient because the data is not reasonably commensurate in scope with the scope of the claims. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). Specifically, the examples only include one type of binder resin, hardener, and metal oxide.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9/2/2008
Vickey Ronesi

/V. R./
Examiner, Art Unit 1796

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/Vasu Jagannathan/

Supervisory Patent Examiner, Art Unit 1796